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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,514	03/01/2001	Nurakhmed Nurislamovich Latypov	47254-00004	1543

23932 7590 10/02/2003

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EXAMINER

LEE, MICHAEL

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 10/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,514

Applicant(s)

LATYPOV ET AL.

Examiner

M. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-21 is/are rejected.
- 7) ☒ Claim(s) 13, 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-7, and 15-21 provide for the use of a method for creating video programs, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-7, and 15-21 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Objections

2. Claim 5 is objected to because of the following informalities: Dependence of this claim is incorrect. It should have been claim 4 instead of claim 1. It is being treated as if depends on claim 4. Appropriate correction is required.

3. Claim 13 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple claim. See MPEP § 608.01(n). Accordingly, for examination purpose, claim 13 is being treated as if depends on claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 8-12, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu et al. (6,086,380).

Regarding claim 1, Chu discloses a personalized video recording system showing karaoke video generating devices (70,72,74) and CPU 76 for generating video images including background scenes and foreground lyrics, which meets the image formed by a computer which includes an image of objects in the foreground and a background image, a camera 30 for capturing the image of a participant 21, and an audio/video mixer 124 and capture card 136 for outputting a mixed video signal of the participant and a selected background video scene from devices 70, 72 or 74. The lyrics of a karaoke video in Chu are displayed to the participant on a TV monitor 42 (col. 14, lines 29-37) at a center level so that the eye contact of the participant can be maintained with the camera 30. However, Chu does not specify that the image formed by the computer is combined with the video image of the participant of the video program by superimposing an image of at least the objects of the foreground on the video image of the participant as claimed. In other words, Chu does not directly suggest in that the selected karaoke video (song) is combined with the participant.

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Instead, a selected scene by the participant is combined with the participant image (col. 12, lines 49-64). In any event, Chu does suggest in that the chosen background scene selected from the hard disk is also transmitted by the DVD/VCD player 74...the chosen background scene is typically a moving scene formed of a number of sequential frames of the selected background subject (col. 14, lines 55-59). This clearly suggests the karaoke background scene could be any video clip stored in the DVD/VCD player 74. Since the selected song by the participant is coming from the DVD/VCD player 74, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to select the same karaoke video clip to be sang by the participant as the karaoke background scene. By doing so, the inherently included foreground lyrics on the karaoke video clip can be superimposed along with the participant image. The selection of such video clip would have been considered an arbitrary user selection choice because the participant can select any available video clip as the background scene.

Regarding claim 2, Chu shows a chroma key backdrop 34. The chroma key in Chu enables only the participant image to be combined with the foreground lyrics and background image of the karaoke video clip.

Regarding claim 3, the lyrics displayed on monitor 42 can be turned on or off by the participant, which meets the possibility of interacting with the displayed objects formed by the computer and the changing the image of the objects.

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Regarding claim 8, in addition of above reasonings, Chu further shows a video camera 30, a means for forming (70,74,72,76), a studio (Figure1), a means for displaying (42), and a means for combining (124,136).

Regarding claim 9, the displayed image 36 intersects with the line of sight of the video camera 30 in Chu (see Figure 1).

Regarding claim 10, Chu shows a screen 28, a semitransparent mirror 36 (see Figure 1).

Regarding claim 11, see rejection to claim 3.

Regarding claim 12, Chu shows an adjustable stool 122 for the participant so that the his line of sight can be adjusted to align with the lyrics displayed on the center of the screen 28, which meets the means for determining the position and orientation of the participant as claimed.

Regarding claim 17, in addition of above reasonings, Chu further shows a chroma keying processing (col. 14, line 65, to col. 15, line 9), which meets the transparent zone as claimed.

Regarding claim 18, in Chu, the chroma key zone of the participant blocks the background karaoke scene, which meets the background image being formed transparent when combined with the video image of the user.

Regarding claim 19, see rejection to claim 3.

Allowable Subject Matter

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5. Claims 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McNelley et al. (5,639,151) shows a camera 20 and projector 8.

Kannes (4,965,819) shows a videoconference communication system.

Burfeind et al. (6,052,648) shows a chroma keying system.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Lee whose telephone number is **703-305-4743**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John Miller**, can be reached at **703-305-4795**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

A handwritten signature in black ink, consisting of a large, stylized loop followed by a horizontal line.

M. Lee
Primary Examiner
Art Unit 2614

September 24, 2003